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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/822,682

04/13/2004

Eric Berreklouw

2001-1105-1

2986

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7590

09/06/2006

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EXAMINER

BLANCO, JAVIER G

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/822,682 | Applicant(s) BERREKLOUW, ERIC | |
| | Examiner Javier G. Blanco | Art Unit 3738 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 72-119 is/are pending in the application.
- 4a) Of the above claim(s) 76,78-87,89,90 and 92-119 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 72-75, 77, 88, and 91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/13/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's cancellation of claims 1-71 in the Preliminary Amendment filed on April 13, 2004 is acknowledged.

Election/Restrictions

2. Applicant's election of Fixing Device: Species II (embodied in Figures 15-25), and Sub-Species A (embodied in Figure 15) in the reply filed on June 21, 2006 is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 85-87 and 92-119 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species/sub-species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on June 21, 2006.

4. It is noted that claim 76 (Figures 16a-b: arms with two pins), claims 78-80 (Figures 20a-b: top and bottom flanges), claims 81-83 (lower limit and top closure), claim 84 (screw thread connection, a bayonet connection or a combination of peripheral recesses), claim 89 (the external surface of the tubular element is concave), and claim 90 (Figures 23a-b: two or more rows of arms) represent some of non-elected sub-species B-J (embodied in Figures 16-24). Therefore, claims 76, 78-84, 89, and 90 are also withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected sub-species B-J (embodied in Figures 16-24) of the elected Species II (embodied in Figures 15-25) group.

Specification

5. The disclosure is objected to because of the following informality: please update the RELATED APPLICATIONS section (e.g. --a division of 09/979,668, filed November 26, 2001, now US 6,790,229--). Appropriate correction is required.

Drawings

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

a. Therefore, the “lower limit” (see claim 81 at line 3; claim 82 at line 2) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

b. Therefore, the “top closure” (see claim 81 at line 7) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

c. Therefore, the “stop” (see claim 82 at line 2) and the “inwardly pointing rib” (see claim 82 at line 4) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

d. Therefore, the “screw ring or snap-fit ring and/or resilient snap-fit lips” (see claim 83 at line 2) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

e. Therefore, the “screw thread connection, a bayonet connection or a combination of peripheral recesses” and “twist lock” (see claim 84) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

f. Therefore, the “the external surface of the tubular element is concave” (see claim 89) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claims 72 and 79 are objected to because of the following informalities:
 - a. Regarding claim 72, please (i) substitute “inside it” (see line 5) with --inside said tubular element--, and (ii) delete “arranged” (see line 6). Appropriate correction is required.
 - b. Regarding claim 79, please delete “arranged” (see line 4). Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 72-84 and 88-91 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 72, “the fitted position” (see line 3) is indefinite as to the scope of what “fitted” means. Also, said limitation lacks antecedent basis.

b. Regarding claim 72, “the outside” (see line 3) lacks antecedent basis.

c. Regarding claim 72, “the peripheral wall part of the circulatory system” (see line 4) is indefinite as to the scope of the invention. Also, said limitation is vague and confusing, rendering said limitation indefinite.

d. Regarding claim 72, “the periphery” (see line 6) lacks antecedent basis.

e. Regarding claim 72, “the fold line respectively bending line” (see lines 14-15) is indefinite as to the scope of the invention. Also, said limitation is vague and confusing, rendering said limitation indefinite.

f. Regarding claim 77, “the fold line respectively bending line” (see lines 3-4) is indefinite as to the scope of the invention. Also, said limitation is vague and confusing, rendering said limitation indefinite.

g. Regarding claim 78, the phrase “such as” (see line 8) renders the claim indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired.

Ex parte Steigewald, 131 USPQ 74.

h. Regarding claim 81, the phrase “such as” (see line 3 and line 7) renders the claim indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. *Ex parte Steigewald*, 131 USPQ 74.

i. Regarding claim 82, the phrase “such as” (see line 3) renders the claim indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. *Ex parte Steigewald*, 131 USPQ 74.

j. Regarding claim 84, the phrase “for example” renders the claim indefinite because the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. *Ex parte Hasche*, 86 USPQ 481.

k. Regarding claim 84, the entire language of said claim is vague and confusing, rendering said claim indefinite as to the scope of the invention.

l. Regarding claim 88, the limitation “have been bent, or can be bent” is indefinite as to the scope of the invention.

m. Regarding claim 88, the limitation “corresponding to essentially” does not clearly set forth the metes and bounds of the patent protection desired.

n. Regarding claim 89, the limitation “the external surface of the tubular element” lacks antecedent basis.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 72-75, 77, 88, and 91 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shiley (US 3,686,740 A; cited in Applicant's IDS).

Referring to Figures 5-7, 9, and 25-30, Shiley discloses a prosthesis fixing device comprising a tubular element (outer ring 11 + inner ring 12), capable of accommodating a prosthesis (e.g., valve 15), having pins (pins 13) distributed around the periphery of said tubular element, said pins having pointed ends, wherein each pin is arranged on an arm which arm, via a fold or bend line, is attached by one end to the tubular element, wherein the arms and pins are capable of moving, by swinging about the fold or bend line, from an insertion position (e.g., Figure 5), in which they are ESSENTIALLY located inside the tubular element, to a fixing position (e.g., Figure 6) in which at least the pins project outside of the tubular element. The tubular element is provided with slit-shaped radial passages (radial slots 35, annulus 52, and/or apertures 41) located alongside the pins in the radial direction.

12. Claims 72-75, 77, and 88 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Marin et al. (US 5,397,355 A).

Referring to Figures 1-5, Marin et al. disclose a prosthesis fixing device comprising a tubular element (stent 10), capable of accommodating a prosthesis, having pins (barbs 18) distributed around the periphery of said tubular element, said pins having pointed ends, wherein each pin is arranged on an arm which arm, via a fold or bend line (see Figures 3 and 4), is attached by one end to the tubular element, wherein the arms and pins are capable of moving, by swinging about the fold or bend line, from an insertion position (e.g., Figure 1), in which they are ESSENTIALLY located inside the tubular element, to a fixing position (e.g., Figures 2 and 4) in

which at least the pins project outside of the tubular element. The tubular element is provided with slit-shaped radial passages (elongated openings 12) located alongside the pins in the radial direction.

Conclusion


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Penny (US 4,182,446 A).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:30 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 703-872-9306 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

JGB

August 29, 2006



David H. Willse
Primary Examiner